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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/023,735

12/21/2001

Timo Elomaa

004770.00357

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BANNER & WITCOFF, LTD.

1100 13th STREET, N.W.

SUITE 1200

WASHINGTON, DC 20005-4051

EXAMINER

LANIER, BENJAMIN E

ART UNIT

PAPER NUMBER

2432

MAIL DATE

DELIVERY MODE

12/29/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                       |                                      |  |
|------------------------------|---------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/023,735  | <b>Applicant(s)</b><br>ELOMAA ET AL. |  |
|                              | <b>Examiner</b><br>BENJAMIN E. LANIER | <b>Art Unit</b><br>2432              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 53-70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 53-70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 26 October 2009 has been entered.

### ***Response to Amendment***

2. Applicant's amendment filed 26 October 2009 cancels claims 6-8, 18, 25, 36, and 41-52. Claims 53-70 have been added. Applicant's amendment has been fully considered and entered.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 53-58, 60-67, 69, 70 are rejected under 35 U.S.C. 102(e) as being anticipated by Tagawa, U.S. Patent No. 7,096,504. Referring to claims 53-56, 58, 63, 64, 66, Tagawa discloses a content distribution system wherein copyrighted material is distributed from a distribution

Art Unit: 2432

server to a cellular phone via a network (Figure 6A & Col. 10, lines 5-9 & Col. 13, lines 18-23), which meets the limitation of a network, a mobile terminal configured to receive a datagram through the network, the datagram comprising a header portion and a payload portion including data content, a communication link providing said content creation tool with access to the network, a memory for storing a received datagram, the indicia data comprises a value indicative of a control or copyright class, the apparatus is a mobile telephone handset, transmitting the datagram to the terminal. Usage rules set by the distribution server dictate what operations can be performed on the copyrighted material by the purchaser (Figure 6A & Col. 6, lines 52-60 & Col. 11, line 55 – Col. 12, line 11), which meets the limitation of a content creation tool configured to determine a level of protection from a plurality of levels of protection for data content, the level of protection indicating which of a plurality of individual user selectable operations are permitted for the data content by user selection at the mobile terminal, the content creation tool being further configured to include indicia data in the datagram to be supplied through the network to the mobile terminal, the indicia data representing the determined level of protection for the data content, the mobile terminal further comprising a processor configured to determine the indicia data in the received datagram and to control individual user selectable operations for the data content at a user according to the level of protection indicated by the indicia data, a user interface, wherein the processor being further configured to control individual user selectable operations for the data content at the user interface according the level of protection indicated by the indicia data.

Referring to claims 57, 67, Tagawa discloses that the usage rules are encrypted (Col. 8, lines 42-48), which meets the limitation of the indicia data is encrypted.

Art Unit: 2432

Referring to claims 60, 69, Tagawa discloses that the copyrighted material is a song and includes audio (Col. 13, lines 29-32), which meets the limitation of the data content comprises a ringtone.

Referring to claims 61, 70, Tagawa discloses that the usage rules comprise at least one of viewing, storing, and forwarding the data content (Col. 11, line 55 – Col. 12, line 11).

Referring to claims 62, 65, Tagawa discloses that the usage rules dictate how many times the copyrighted material can be transferred from one storage device to another (Col. 11, line 55 – Col. 12, line 11), which meets the limitation of said apparatus comprises a volatile memory and a non-volatile memory and said user selectable operations for the data content comprise transferring the data content from said volatile memory to said non-volatile memory. Tagawa does not expressly disclose that the cellular phone includes a volatile memory, however, volatile memory is inherent to cellular phones as discussed on Tagawa.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

Art Unit: 2432

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
8. Claims 59, 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tagawa, U.S. Patent No. 7,096,504, in view of Dolan, U.S. Patent No. 6,977,921. Referring to claims 59, 68, Tagawa does not disclose that the copyrighted material is transmitted to the cellular phone in a short message. Dolan discloses transmitted audio data in a short message to cellular phones (Abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to transmit the copyrighted material of Tagawa in a short message to provide a convenient way to send audio directly to a user of a cellular phone as taught by Dolan (Col. 2, lines 12-15).

#### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENJAMIN E. LANIER whose telephone number is (571)272-3805. The examiner can normally be reached on M-Th 7:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2432

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Benjamin E Lanier/  
Primary Examiner, Art Unit 2432